Please add the following Claims:

- - 68. The method of Claim 38 wherein the bacterial cell is not killed by a peptide having the amino acid sequence of SEQ ID NO:2.

69. The method of Claim 39 wherein the bacterial cell is not killed by a peptide having the amino acid sequence of SEQ ID NO:2. - -

REMARKS

The Applicants have amended the Specification to comport with the requirements of 37 CFR 1.821 through 1.825.

The Applicants have canceled Claims 1-33, and 40-67 without prejudice because the Examiner has withdrawn them from consideration as being the subject matter of a different invention. The Applicants have amended Claim 34 and added Claims 68 and 69 to more particularly point out and distinctly claim that which the Applicants regard as their invention. Support for the amendment to Claim 34, and Claims 68 and 69 can be found throughout the Specification as filed including in the original claims. Further support for the amendment to Claim 34 can be found on Page 33, lines 22-32, and on Page 35, lines 8-20. No new matter has been added. Claims 34-39, 68 and 69 are pending. Reconsideration of this Application is respectfully solicited.

Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 34-39 asserting that they are anticipated by Williamson and Tomasz under 35 U.S.C. § 102(b). The Examiner asserts that the cells described by Williamson and Tomasz have an identical biological phenotype, *e.g.*, vancomycin tolerance, as the cells of the claimed methods. The Examiner asserts that Novak *et al.* (1999) teach that vancomycin tolerance in mutant *Streptococcus pneumoniae* is due to their lacking a functional sensor histidine kinase or a functional response regulator, components that are important in the His-Asp phosphorelay signal transduction pathway. The Examiner further asserts that the skilled artisan would conclude that the cells of Williamson

and Tomasz would not be killed by the peptide having the amino acid sequence of SEQ ID NO: 2. The Examiner concludes by stating that the U.S. Patent Office does not have the facilities for examining and comparing the cells being claimed with those of Williamson and Tomasz and therefore must assume that they are the same.

The Applicants respectfully traverse the Examiner's rejections. The Applicants have amended the claims to more particularly point out and distinctly claim that which the Applicants consider to be their invention. As the Examiner has correctly noted, Novak *et al.* (1999) showed that mutant *Streptococcus pneumoniae* lacking a functional sensor histidine kinase or a functional response regulator were vancomycin tolerant.

However, contrary to the Examiner's assertion, Novak *et al.* (1999) do not teach that the converse of their determination is true. Indeed, Novak *et al.* (1999) never state that all vancomycin tolerant *Streptococcus pneumoniae* lack a functional sensor histidine kinase or a functional response regulator, since vancomycin tolerance in *Streptococcus pneumoniae* can be caused by a number of different factors. Thus, Novak *et al.* (1999) simply demonstrated that one such factor is a defective His-Asp phosphorelay pathway. Therefore, whereas mutant *Streptococcus pneumoniae* lacking a functional sensor histidine kinase or a functional response regulator were shown to be vancomycin tolerant, all vancomycin tolerant *Streptococcus pneumoniae* do not have a defective His-Asp phosphorelay pathway.

The present invention provides methods of using cells that specifically have a defective His-Asp phosphorelay pathway. Williamson and Tomasz, on the other hand, only provide cells that are vancomycin tolerant. It is therefore unreasonable to assume that all (if any) of the cells of Williamson and Tomasz have a defective His-Asp phosphorelay pathway, since Williamson and Tomasz made no effort to distinguish the genotypes of their cells.

The Federal Circuit has held that:,

"[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject-matter."*PPG Industries, Inc. v. Guardian Industries Corp.*, 37 USPQ2d 1618 (Fed. Cir. 1996).

In the present case, Williamson and Tomasz have not provided the requisite cells with the specific genotype for performing the claimed methods. Indeed, whereas Williamson and Tomasz isolated cells based on a particular phenotype, the cells of the present invention are selected for a specific genotype. For the reasons stated above, these two different means of selection are clearly not equivalent. Therefore, Williamson and Tomasz cannot anticipate the invention as claimed.

In view of the above and foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 (b) are respectfully solicited.

From the above and foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

No fees are believed to be necessitated by the foregoing amendments. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,
KLAUBER & JACKSON

Michael D. Davis

Michael D. Davis
Registration No. 39,161

Continental Plaza
411 Hackensack Avenue
Hackensack, New Jersey 07601
(201) 487-5800

Date: August 31, 2000